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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,746	12/07/2001	Van Barlow	510P004	8798

7590

04/09/2003

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EXAMINER

LOPEZ, MICHELLE

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,746

Applicant(s)

BARLOW ET AL. CN

Examiner

Michelle Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 9-12 recites the limitation "the insulated staple of claim 7" in the introductory clause. The limitation lacks of antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wingert (US Pat. 5,735,444) in view of Kish et al. (US Pat. 5,441,373). Wingert discloses the invention substantially as claimed including a housing "56", a driver (see Fig. 3), an actuator (see Fig.1), a detachable magazine assembly "70", one or more coated fasteners (see Fig. 7), a nose "60", a tail end (see Fig.7), a pusher "72", staples "14", a bight portion and a pair of legs (see Fig. 6), a coating adhering to the bight portion and the legs to form an integral unitary structure (col.1, lines 40-48). Wingert does not disclose a coated fastener with an electrically insulating coating. However, Kish teaches a coated fastener with a nylon coating (col. 4, lines 59-66) for the

purpose of providing electrically insulating properties to the fastener. In view of Kish, it would be obvious to one having ordinary skill in the art to have provided Wingert's invention including a coated fastener with a nylon coating which provide electrically insulating properties to the fastener in order to minimize the possibility that the fastener penetrate or damage the sheathing on a wire and cause an electrical short circuit.

Regarding claim 3, Wingert does not specifically state that the coating has cushioning properties. However, Examiner takes Official Notice of the well-known act of provide Wingert's invention including a fastener having a coating with cushioning properties for the purpose of fastening a staple to a wire without damaging or deforming the wire. It would have been obvious to one having ordinary skill in the art to have provided Wingert's invention including a staple having a coating with cushioning properties in order to attach a staple to a wire without causing damage or deformation of the wire that could create a short circuit or other effects on the electrical current being transmitted.

Regarding claim 8, Wingert does not disclose a dielectric coating uniformly coated to the bight portion and the pair of legs. However, Kish teaches a dielectric coating uniformly coated to the bight portion and the pair of legs for the purpose of forming an integral unitary structure (col.1, lines 40-48). In view of Kish, it would have been obvious to one having ordinary skill in the art to have provided Wingert's invention including a dielectric coating uniformly coated to the bight portion and the pair of legs in order to form an integral unitary structure with electrically insulating properties.

Regarding claim 10, it would have been obvious to one having ordinary skill in the art to have provided Wingert's invention including a coating thickness range from about 0.001 inches to 0.050 inches as a matter of design choice.

Regarding claim 11, Wingert does not disclose a staple made of steel. However, Kiss teaches a staple made of steel (col. 1, lines 34-35) for the purpose of providing a staple with the required hardness and stiffness properties. In view of Kiss, it would have been obvious to one having ordinary skill in the art to have provided Wingert's invention including a staple made of steel in order to provide a staple with the required hardness and stiffness properties assuring the penetration and fastening of the staple into a substrate.

Regarding claim 12, Wingert does not disclose that each free end of the staple terminates in an angled cut. However, Kiss teaches a staple with angled cut free ends for the purpose of facilitating the penetration of the staple into a substrate. In view of Kiss, it would have been obvious to one having ordinary skill in the art to have provided Wingert's invention including a staple with angled cut free ends in order to facilitate the penetration of the staple into a substrate.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 703-305-8205. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-7769 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ML

March 27, 2003

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a long horizontal line extending to the right.

Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700